

REMARKS

The Amendments

The claims are replaced with new claims which are of a more limited scope and which put the claims in a form more customary to US practice, including addressing the 35 U.S.C. §112 rejections herein.

Applicants reserve the right to file one or more continuing and/or divisional applications directed to any subject matter disclosed in the application which has been canceled by any of the above amendments.

The Restriction and Election of Species Requirements

The claims have been amended so that they are directed to the embodiments wherein Y is a phenyl ring, optionally substituted, A is a pyridine ring, optionally substituted, and R¹R²N- forms a pyrrolidine group, optionally substituted. Thus, the compounds encompassed by the compound claims are within the elected Group III of the restriction requirement. It is believed that, by this amendment, the restriction among the compound claims should be moot, see further comments below. The method claims are retained as they may be subject to rejoinder.

Although the restriction requirement may be moot, applicants do want to address the comments thereon in the Office Action. It was alleged that the previous claims were so broad that a search could not be done. The current claims are significantly narrowed and, in any event, applicants urge that mere breadth of the claims alone is not a sufficient basis to support restriction or support the PTO taking a position that the invention will not be searched or examined. When claims are considered particularly broad, the PTO has the option of Markush practice to narrow the initial search, if necessary. Applicants do not see the significance of the statement that “the structure of formula I does not even belong to a recognized class of compounds.” Claims need not be limited in scope to some recognized class of compounds and no basis is seen in the law or practice to support a restriction requirement or rejection based on such allegation. Applicants also do not appreciate the allegation that “it is not clear from claim 1 what compounds are actually being claimed” and particularly the allegation that “applicants have no idea of what compounds are being

claimed!” That the claim may be of a broad scope and may have complex possibilities of substitution does not mean that it would not be evident to one ordinarily skilled in chemistry to determine the metes and bounds of what compounds are being claimed -- particularly in view of the ample support and representative examples provided in the disclosure. That the claims have long recitations regarding the substituents reflects a great attention to detail in defining the exact scope of the possible substituents, contrary to the alleged absence of knowledge thereof. Further, that applicants’ representative previously made an honest mistake in not coinciding the elected group with the elected species does not warrant the attack on applicants alleging that they do not know what compounds their own claims encompass. The PTO should understand that patent applications and claims, as a necessity, come in many forms and the fact that a particular application/claim may not comply with what the PTO may prefer does not support the restriction or rejection thereof if such is not warranted by the laws or PTO rules. It certainly does not warrant the attack made herein, alleging that the applicants are ignorant of the nature of their own invention.

If the restriction is to be maintained, applicants urge that a proper and objective basis be provided therefore.

The Rejection under 35 U.S.C. §112, first paragraph

The rejection of claims 1 and 3 under 35 U.S.C. §112, first paragraph, is believed to be rendered moot by the above amendments. The rejection was based on the recitation of the terms “residues” and “group cleaved in vivo.” These terms do not appear in the current claims. Thus, the rejection should be withdrawn.

The Rejection under 35 U.S.C. §112, second paragraph

The rejection of claims 1-17 under 35 U.S.C. §112, second paragraph, is respectfully traversed. It is believed that the rejection is at least partially, if not fully, rendered moot by the above amendments. The current claims do not contain the terms which gave rise to the points of rejection.

The Provisional Obviousness-type Double Patenting Rejections

The provisional obviousness-type double patenting rejections over copending

applications, Ser. Nos. 11/104,889 and 11/104,915, are each respectfully traversed. Both of the copending applications were filed after the current application, i.e., the current application is the earliest filed application. In accordance with MPEP §804(I)(B)(1), a terminal disclaimer should not be required in this earliest application and the provisional obviousness-type double patenting rejections over the other two applications should be withdrawn.

In any event, all of these applications are currently being prosecuted and the claims may change during prosecution. Thus, taking positive action, such as filing a terminal disclaimer, would be premature at this point.

The Claim Objections

The objection to claims 2-14 is rendered moot by the above amendments.

It is submitted that the claims are in condition for allowance. However, the Examiner is kindly invited to contact the undersigned to discuss any unresolved matters.

No fee other than the 2-Month Extension of Time, herewith paid through EFS, is believed due, however, the Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

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